



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

p

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,748	07/15/2003	Andreas Mau	13905-020001 / 2003P00354	7407
22852	7590	01/19/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			GOTTSCHALK, MARTIN A	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/619,748

Applicant(s)

MAU, ANDREAS

Examiner

Martin A. Gottschalk

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/30/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 08/30/2005. Claims 1-30 remain pending. Claims 1, 10, 13, 25, and 26 have been amended. Claims 27-30 are new.

Claim Rejections - 35 USC § 101

2. The rejections of the claims under 35 U.S.C. 101 is hereby withdrawn due to amendment.

Claim Rejections - 35 USC § 112

3. The rejections of the claims under 35 U.S.C. 112, second paragraph, made in the first Office Action is hereby withdrawn due to amendment.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 3626

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1,13, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the E-Benefits Inc. website (hereinafter E-Benefits; see the related non-patent literature attachment pages) in view of DeBra et al (DeBra, P.M.E., and Post, R. D. J; Searching for Arbitrary Information in the WWW: the Fish-Search for Mosaic, hereinafter DeBra; see the related non-patent literature attachment pages).

A. As per claim 1, E-Benefits discloses a method for managing employee benefits in real-time (E-Benefits: pg 1, second paragraph, "E-Benefits Quote Wizard brings choice and clarity to employee benefits selection by enabling business to easily and cost effectively select, purchase and manage employee benefits."), the method comprising:

receiving, from an employer, requirements for benefits (E-Benefits: pg 3, item 1. The Examiner considers "Using search criteria that you provide..." to mean the employer requirements (criteria), in order to be used, would have had to have been received from the employer).

electronically preparing a search message including the requirements for benefits (E-Benefits: pg 3, item 1. The Examiner considers "Using search criteria that you

Art Unit: 3626

provide..." to indicate preparation of an electronic search message which provides the criteria;

transmitting the search message only to a select number of benefits providers based on the number of nodes (E-Benefits: pg 3, item 1. The Examiner considers E-Benefits to be a form of benefits provider, as well as a select number of benefits providers, where the number is one. The Examiner further considers the employer's provision of "search criteria" to be a form of transmitting benefits requirements to a benefit provider.);

receiving bids from the select number of benefits providers to satisfy the requirements for benefits (E-Benefits: pg 3, item 2. The Examiner considers E-Benefits to be a form of a select number of benefits provider and an employer selecting from "available employee benefits options" to be a form of receiving bids from the select number benefits providers.);

transmitting the bids to the employer (E-Benefits: pg 3, items 1 and 2. The Examiner notes that in order to "Select from available employee benefits..." in item 2, the results of item 1 would have had to have been transmitted to the employer.);

receiving, from the employer, an authorization to enroll benefits of a selected benefits provider from the one or more benefits providers (E-Benefits: pg 3, item 3.

The Examiner considers an employer completing the process of "...enrolling online with E-Benefits..." to be a form of a benefits provider receiving an authorization to enroll benefits of a selected benefits provider); and

transmitting the authorization to the selected benefits provider (E-Benefits: pg 3, item 3. The Examiner considers an employer completing the process of "...enrolling online with E-Benefits..." to be a form of transmitting an authorization to the selected benefits provider.).

While E-Benefits suggests the inclusion of a number of nodes in the search message, such as when the number is one as noted above in the first transmitting step, E-Benefits fails to explicitly disclose

electronically preparing a search message including a number of nodes for the search;

However this feature is well known in the art as evidenced by the teachings of DeBra.

DeBra teaches a WWW search tool where the search message includes a number of nodes for the search (DeBra: pg 4, Fig 1, items labeled "Depth of Search" and "Width of Search"; pg 6, descriptions of "Depth of Search" and "Width of Search").

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the teachings of DeBra within the method of E-Benefits with the motivation of providing a faster, optimized search that searches the entire contents of a node rather than just a title or header (DeBra: pg 3, second bullet point of section 1.).

B. As per claim 27, E-Benefits discloses the method of claim 1, wherein the search message further includes networking requirements (note that E-Benefits operates via a website, and as such, includes networking requirements in any messages sent in order to enable the messages to be sent over the WWW).

7. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over E-Benefits in view of DeBra as applied to claim 1 above, and further in view of Tomsen (Tomsen, Mai-lan; Killer Content: Strategies for Web Content and E-Commerce.; Addison Wesley Longman, Inc. Reading, Massachusetts; April, 2000; pgs 13; 129-133; and 177-180.; hereinafter Tomsen).

A. As per claim 29, E-Benefits suggests the method of claim 1, further comprising

providing a reimbursement to each of the select number of benefits providers (E-Benefits: pg 3, item 3. The Examiner considers the step of "QuickEnroll" to include a payment from a purchaser to the selected benefit provider.).

E-Benefits fails to explicitly show this feature. However, this feature is well known in the art as evidenced by the teachings of Tomsen.

Tomsen discloses the implementation of an "affiliate program" where a first web site publisher pays a second for driving customer or user traffic to the first web site. Typically the payment is a percentage of a sale made by the first web site to a user who arrives at the first web site via a link provided on the second website (Tomsen: pg 13, first paragraph and boxed information at bottom of page). Some programs are not based on a transaction, but are used simply to drive up site traffic and increase brand recognition. So for instance, following the teachings of Tomsen, E-Benefits could place a banner on other benefits providers web sites and pay the providers for every user who links to the E-Benefits site from another benefits providers sites (Tomsen: pg 129, section labeled "Set Up Smart Affiliate Relationships", first paragraph).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Tomsen with the method of E-Benefits, with the motivation being to widen the breadth of the E-Benefits net user base (Tomsen: pg 129, section labeled "Set Up Smart Affiliate Relationships", first paragraph).

8. As per claims 13, 28, and 30, they are article of manufacture claims which repeat the same limitations of claims 1, 27, and 29 respectively, the corresponding method claims, as a collection of executable instructions stored on machine readable media, as opposed to a series of process steps. Since the teachings of E-Benefits, DeBra, and

Tomsen disclose the underlying process steps that constitute the method of claims 1, 27, and 29, it is respectfully submitted that they likewise disclose the executable instructions that perform the steps as well. As such, the limitations of claim 13, 28, and 30 are rejected for the same reasons given above for claims 1, 27, and 29, respectively.

9. Claim 10 has been amended to reflect its depending from claim 9. The original claim recited claim 10 depending from itself, and it appears the amendment was merely the correction of a typographical error. Claim 10 is thus rejected for the same reasons as provided in the first Office Action.

10. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over E-Benefits in view of DeBra, and further in view of Gupta (PG Pub# 2003/0009355; hereinafter Gupta.).

A. As per claim 25, E-Benefits discloses a system for managing employee benefits in real-time (E-Benefits: pg 1, second paragraph, "E-Benefits Quote Wizard brings choice and clarity to employee benefits selection by enabling business to easily and cost effectively select, purchase and manage employee benefits."), the system comprising:

one or more computers to manage information for a select number of benefits providers (E-Benefits: pg 3, item 1 and 2 in particular), at least one computer configured to:

receive, via a network, requirements for benefits services for an employee (E-Benefits: pg 3, item 1. The Examiner considers "Using search criteria that you provide..." to mean the employer requirements (criteria), in order to be used, would have had to have been received from the employer. The Examiner further notes that the requirements from the employer would be for benefits for employees. The Examiner further notes that the system of E-Benefits is Web based, and as such, receiving and transmitting are done over a network.);

electronically preparing a search message including the requirements for benefits (E-Benefits: pg 3, item 1. The Examiner considers "Using search criteria that you provide..." to indicate preparation of an electronic search message which provides the criteria);

transmit the search message, via the network, only to the one or more of the computers managing information for the select number of benefits providers based on the number of nodes (E-Benefits: pg 3, item 1. The Examiner considers E-Benefits to be a form of benefits provider, as well as a select number of benefits providers, i.e. one benefit provider. The E-Benefits computer is thus a node, and a search message sent to E-Benefits is based on the number of nodes, i.e. one node. The Examiner further considers the employer's provision

of "search criteria" to be a form of transmitting benefits requirements to a benefit provider.);

receive, via the network, bids to satisfy the requirements for benefits services from the one or more computers (E-Benefits: pg 3, item 2. The Examiner considers an employer selecting from "available employee benefits options" to be a form of receiving bids from benefits providers. Since the employer is doing this from a computer connected to the Internet, the bids are received via a network.);

receive, via the network, an authorization to enroll the services of a selected benefits provider from the one or more computers (E-Benefits: pg 3, item 3. The Examiner considers an employer completing the process of "...enrolling online with E-Benefits..." to be a form of a benefits provider receiving an authorization to enroll benefits of a selected benefits provider via a network);

transmit the bids via the network (E-Benefits: pg 3, item 2. The Examiner considers an employer selecting from "available employee benefits options" to mean the bids had been transmitted. Since the employer is performing this step from a computer connected to the Internet, the bids are received via a network.);

transmit the authorization via the network to a computer managing information for the selected benefits provider (E-Benefits: pg 3, item 3. The Examiner considers an employer completing the process of "...enrolling online with E-Benefits..." to be a form of transmitting an authorization to the selected benefits provider. Since the transmission is done over the Internet, it is via a network).

While E-Benefits suggests the inclusion of a number of nodes in the search message, such as when the number is one as noted above in the first transmitting step, the teachings of E-Benefits fails to explicitly disclose

electronically preparing a search message including a number of nodes for the search;

However this feature is well known in the art as evidenced by the teachings of DeBra.

DeBra teaches a WWW search tool where the search message includes a number of nodes for the search (DeBra: pg 4, Fig 1, items labeled "Depth of Search" and "Width of Search"; pg 6, descriptions of "Depth of Search" and "Width of Search").

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the teachings of DeBra within the method of E-Benefits with the

Art Unit: 3626

motivation of providing a faster, optimized search that searches the entire contents of a node rather than just a title or header (DeBra: pg 3, second bullet point of section 1.).

The combined teachings of E-Benefits and DeBra fails to disclose:

an Enterprise Resource Planning (ERP) system to manage human resources information for a company with employees; and

one or more computers to manage information for one or more benefits providers, at least one computer configured to:

receive, via a network and the ERP system, requirements for benefits services for an employee;

receive, via the network and from the ERP system, an authorization to enroll the services of a selected benefits provider from the one or more computers;

transmit the bids to the ERP system via the network.

However, these features are well known in the art as evidenced by Gupta.

Gupta discloses an Enterprise Resource Planning (ERP) system to manage employee benefits amongst a plurality of stakeholders involved in the employee benefit process, where information is transmitted and received between them (Gupta: [0010]).

It would have been obvious at the time of the invention to combine the use of an ERP system as disclosed by Gupta with the combined teachings of E-Benefits and DeBra for the purpose of reducing administrative time and costs, providing healthcare providers reimbursement in a timely manner, and streamlining communication among the various stakeholders involved in the employee benefit process (Gupta: [0008]).

B. As per claim 26, E-Benefits discloses a system for managing employee benefits in real-time (E-Benefits: pg 1, second paragraph, "E-Benefits Quote Wizard brings choice and clarity to employee benefits selection by enabling business to easily and cost effectively select, purchase and manage employee benefits."); the system comprising:

one or more computers to manage information for a select number of benefits providers (E-Benefits: pg 3, item 1 and 2 in particular, the Examiner considers E-Benefits to a form of benefits providers, as well as a select number of benefits providers, with the number being one), at least one computer configured to:

obtain the requirements for benefits services for an employee (E-Benefits: pg 3, item 1. The Examiner considers "Using search criteria that you provide..." to mean the employer requirements (criteria), in order to be used, would have had to have been obtained from the employer. The Examiner further notes that the requirements from the employer would be for benefits for employees.);

prepare a search message including the requirements for benefits (E-Benefits: pg 3, item 1. The Examiner considers "Using search criteria that you provide..." to indicate preparation of a search message which provides the criteria);

transmit, via the network, the search message only to the one or more computers based on the number of nodes (E-Benefits: pg 3, item 1. The Examiner considers E-Benefits to be a form of benefits provider, as well as a select number of benefits providers, i.e. one benefit provider. The E-Benefits computer is thus a node, and a search message sent to E-Benefits is based on the number of nodes, i.e. one node. The Examiner further considers the employer's provision of "search criteria" to be a form of transmitting benefits requirements to a benefit provider.);

receive, via the network, bids to satisfy the requirements from the one or more computers (E-Benefits: pg 3, item 2. The Examiner considers an employer

Art Unit: 3626

selecting from "available employee benefits options" to be a form of receiving bids from benefits providers. Since the employer is doing this from a computer connected to the Internet, the bids are received via a network.);

transmit the bids (E-Benefits: pg 3, item 2. The Examiner considers an employer selecting from "available employee benefits options" to mean the bids had been transmitted.);

obtain an authorization to enroll the services of a selected benefits provider (E-Benefits: pg 3, item 3. The Examiner considers an employer completing the process of "...enrolling online with E-Benefits..." to be a form of obtaining an authorization to enroll benefits of a selected benefits provider);

transmit via the network, the authorization to a computer managing information for the selected benefits provider (E-Benefits: pg 3, item 3. The Examiner considers an employer completing the process of "...enrolling online with E-Benefits..." to be a form of transmitting an authorization to the selected benefits provider. Since the transmission is done over the Internet, it is via a network).

While E-Benefits suggests the inclusion of a number of nodes in the search message, such as when the number is one as noted above in the first transmitting step, the teachings of E-Benefits fails to explicitly disclose

prepare a search message including a number of nodes for the search;

However this feature is well known in the art as evidenced by the teachings of DeBra.

DeBra teaches a WWW search tool where the search message includes a number of nodes for the search (DeBra: pg 4, Fig 1, items labeled "Depth of Search" and "Width of Search"; pg 6, descriptions of "Depth of Search" and "Width of Search").

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the teachings of DeBra within the method of E-Benefits with the motivation of providing a faster, optimized search that searches the entire contents of a node rather than just a title or header (DeBra: pg 3, second bullet point of section 1.).

The combined teachings of E-Benefits and DeBra fails to disclose:

an Enterprise Resource Planning (ERP) system to manage human resources information for a company with employees.

However, this feature is well known in the art as evidenced by Gupta.

Gupta discloses an Enterprise Resource Planning (ERP) system to manage employee benefits amongst a plurality of stakeholders involved in the employee benefit process, where information is transmitted and received between them (Gupta: [0010]).

It would have been obvious at the time of the invention to combine the use of an ERP system as disclosed by Gupta with the combined teachings of E-Benefits and DeBra for the purpose of reducing administrative time and costs, providing healthcare providers reimbursement in a timely manner, and streamlining communication among the various stakeholders involved in the employee benefit process (Gupta: [0008]).

11. All other claims are unamended and are rejected under the

Response to Arguments

12. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5.

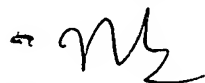
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/619,748


Page 19

Art Unit: 3626



MG

10/04/2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER